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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/909,248

07/19/2001

Biswa R. Banerjee

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9312

7590

04/23/2004

Patent Administrator
Suite 1600
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Chicago, IL 60661-3693

EXAMINER

BRIER, JEFFERY A

ART UNIT

PAPER NUMBER

2672

15

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,248

Applicant(s)

BANERJEE ET AL.

Examiner

Jeffery A Brier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,6 and 7 is/are allowed.
- 6) ☒ Claim(s) 1,6 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to amendment

1. The amendment filed on 3/15/04 has been entered. The amendment to line 3 of claim 1 overcomes the previous 112 second paragraph lack of antecedent basis rejection.

Claim Objection

2. Claim 1 is objected to because of the following informalities: In claim 1 at line 12 "said application program" should be "an application program". Appropriate correction is required.

Response to arguments

3. Applicant's arguments filed 3/15/04 have been fully considered but they are not persuasive. At page 5 applicant argues the application programs which form part of the present invention provide the functionality to enable the pen events to be translated for use in both a mouse mode and a pen mode. Applicant did not specify which application programs perform this functionality. It is clear from applicants specification that pen windows 310, see figure 3a, is operating on the host computer in RC manager 350 to determine whether a pen event is a mouse mode event or a pen mode event and it is clear view manager 200 in the hand held device, see figures 3c and 4, attempts to anticipate which of those modes is applicable for that pen event in order to provide quick local inking. See page 22 line 31 to page 23 line 18. However, applicant failed to note the claims do not claim this. Claim 1 claims at lines 16-20 the input subsystem of

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the mobile user interface device, not the argued applications program, provide the functionality to enable the pen events to be translated for use in both a mouse mode and a pen mode. Claim 6 claims at lines 5-10 the controller of the hand-held interface device, not the argued applications program, provide the functionality to enable the pen events to be translated for use in both a mouse mode and a pen mode. The claims do not make a distinction between the Pen Windows 310 operating in the host computer and the view manager 200 operating in the hand held device. Since the Pen Windows 310 has overall control over the determination of whether a pen event is a pen mode event or a mouse mode event then the means plus function language is at least claiming the Pen Windows 310 located in the host computer as the input subsystem of claim 1 and the controller of claim 6. Thus, the claims need to be amended to claim applicants invention of having view manager 200 located in the hand held device anticipate pen mode events and anticipate mouse mode events while Pen Windows 310 located in the host computer makes the final determination and if the anticipation was incorrect then view manager 200 must correct any anticipated inking or mouse mode with the host determined inking or mouse mode. Refer to figure 4 and its accompanying description in the specification. Since the host computer makes the actual determination and the hand held device merely anticipates and since claim 1 does not claim where the subsystem is located and since the input subsystem is actually located in both the hand held device and the host computer then the rejection based upon McCain and Pen Windows is maintained. Since claim 6 does not claim where the controller is located and since the controller is actually located in both the hand held

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device and the host computer then the rejection based upon McCain and Pen Windows is maintained.

4. Claims 1, 6 and 7 of this application do not claim the limitations that made the claims in the parent application patentable over the prior art of record and the prior art rejection in this application does not raise a cloud of patentability on the parent patent because the same base reference, McCain, used in the parent application is the basis for the following prior art rejection.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCain, U.S. Patent No. 5,309,351, in view of applicants admission of Pen Windows. The rejection set forth in paragraph 5 spanning pages 3 to 8 of paper no. 13 mailed 09/12/03 is maintained and incorporated by reference. Since the means plus function limitations do not clearly claim which subsystem or controller, view manager 200 which anticipates or Pen Windows 310 which makes the final decision, is being claimed then the admitted Pen Windows prior art teaches that the added limitations in

this 3/15/04 amendment and the 8/12/03 amendment would have been obvious to one of ordinary skill in the art.

Prior Art

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rodgers et al., U.S. Patent No. 4,672,154, teaches at column 10 lines 8-20, column 15 lines 15-53 and column 23 lines 12-34 a digitizing system that determines if the tablet is in a tablet mode (applicants pen mode) or mouse mode and provides this via conductor 75 to an external computer. The only difference between the claims and this reference is this reference does not explicitly teach the type of communication means used to communicate the information from the digitizing tablet to the computer. From case law it would have been obvious to make the communication means wireless. Applicant needs to amend the claims to claim the anticipation feature of view manager 200 and the final determination made by the Pen Windows operating in the host computer and that if the anticipation is incorrect then view manager 200 corrects the incorrectly anticipated local inking and mouse mode to correctly reflect the pen event as pen mode or mouse mode.

Ulrich, U.S. Patent No. 5,566,248, teaches an interface routine that is independent of the computer's operating system, any application program, and any of the recognizer routines (which is in Pen Windows, see column 2 lines 37-52). At column 6 lines 55-60 the interface routine is labeled REI. At column 10 lines 3-20 the

interface routine, REI, is described as determining pen events generated by a pen and mouse events generated by a mouse.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

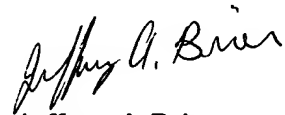
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is 703-305-4723. The examiner can normally be reached on M-F from 6:30 to 3:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (703) 305-4713). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffery A Brier
Primary Examiner
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